IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

James F. RIORDAN et al.

Examiner: PYZOCHA, Michael J

Serial No: 09/821,584

Art Unit: 2137

Filed: March 29, 2001

For: SYSTEM, METHOD AND SOFTWARE FOR
      SUPPLYING ACTIVATION INFORMATION TO A
      SUBSYSTEM

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

    Applicants request review of the final rejection in the above-identified application. No amendments are being filed with this request.

    This request is being filed concurrently with a notice of appeal and before filing of an appeal brief.

    The review is requested for the reasons stated on the attached sheets totaling five (5) or fewer pages.

Respectfully submitted,

Dated: April 30, 2007

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REASONS FOR REQUEST FOR REVIEW

Applicants request review of the Final Office Action ("FOA") in the present application. Claims 30-38 are pending in the application, with claim 30 being an independent claim.

Claim 30 recites, in part, "an activation token identifying system characteristics and specifying a threat level and at least one preset activation measure, wherein a system characteristic is one of the group of a hardware system, a service, a configuration of a service, a service execution platform, and a service version."

This element of claim 30 not only requires the existence of an activation token but also imposes several limitations on the contents of the activation token. The system characteristic identified by the activation token must be one of the listed types. The activation token must specify a threat level. Furthermore, the activation token must specify at least one preset activation measure.

In rejecting claim 30, the Examiner alleges that "Norton discloses a security system comprising: an activation token identifying system characteristics and specifying a threat level and at least one preset activation measure (see pages 37-40)." FOA, pg. 3. The passage cited by the Examiner discloses transmitting "virus definitions files" from a first computing system to a second computing system. Norton, pg. 37. The cited passage is primarily concerned with the mechanics of transmitting the virus definitions files. Absent from the cited passage or any other discussion of the virus definitions files in Norton is a precise description of the contents of the virus definitions files. In particular, no mention is made of the virus definition files specifying a threat level. Nor is any mention made of the virus definition files specifying at least one preset activation measure or identifying system characteristics that are one of the group of a hardware system, a service, a configuration of a service, a service execution platform, and a service version.

In response, the Examiner argues, "With respect to Applicant's argument that Norton fails to disclose a threat level, as disclosed on page 38 Norton discloses that when a major threat (i.e. a higher threat level than previous levels) is discovered the system will email the user in order to update the

virus definitions and these definitions fixing the major threat are downloaded from via the email using the LiveUpdate." FOA, pg. 7. It is respectfully submitted, however, that the Applicants do not argue Norton fails to disclose a threat level. The Applicants contend that Norton does not disclose the virus definition files specify a threat level. Under an anticipation rejection, the identical invention must be shown in as complete detail as is contained in the claim. MPEP 2131 citing *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Norton states, "Whenever a major threat is discovered that requires an update to your virus protection, Symantec can notify you by email so you can run LiveUpdate immediately." Norton, pg. 38. Absent from Norton is any teaching that the virus definition files specify the threat level.

In other words, the Examiner contends that virus definition files are equivalent to activation tokens and argues that Norton notifies clients via email when a major virus threat is discovered. However, claim 30 requires that the activation token specify a threat level. Norton does not teach the virus definition files specify a threat level, and the Examiner has not presented any evidence in the record to the contrary.

The Examiner also argues, "With respect to Applicant's [argument] that Norton fails to disclose one of the specific system characteristics, Norton at least discloses 'a service' because the system must [contact] the Norton virus scanner in order to obtain and use the virus definition updates . . . ." FOA, pg. 7. This argument again illustrates that not all the limitations of claim 30 have been considered by the Examiner.

Claim 30 recites, "an activation token identifying system characteristics . . . , wherein a system characteristic is one of the group of a hardware system, a service, a configuration of a service, a service execution platform, and a service version." Thus, it is not enough that Norton disclose a service, as contended in the Final Office Action. Claim 30 requires, among other limitations, that a service be identified by an activation token.

The Examiner also argues, "With respect to Applicant's argument that Norton fails to disclose at least one preset activation measure, the virus definitions give the virus scanner the information needed to find the virus and remove the virus. Therefore, this scanning for and removing of a virus

is the at least one preset activation measure." FOA, pg. 8.

Once more the Applicants submit that the Examiner has ignored the language of claim 30. Claim 30 requires the <u>activation token</u> specify at least one preset activation measure. It is not enough for Norton to disclose a preset activation measure. Norton must disclose that a preset activation measure is specified by the activation token. Although the Examiner argues that the virus definitions of Norton give the virus scanner the information needed to find the virus and remove the virus, there is no discussion in Norton that the virus definition includes at least one preset activation measure.

For at least these reasons, the final rejection of claim 30 is believed to be clearly in error.

Respectfully submitted,

Dated: April 30, 2007

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